

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1, 2, 4, 5, 7-9, 11, 16, 21-23, 28, 51-53, and 71-74 are pending in this application.

The claims are subjected to a restriction requirement under 35 U.S.C. §121 as containing two distinct inventions:

- I. Claims 1, 2, 4, 5, 7-9, 11, 16, 21-23, 28, and 71-74 are drawn to methods of synthesizing nucleic acid sequences, classified in class 435, subclass 6.
- II. Claims 51-53 are drawn to a tagged reference nucleic acid, classified in class 536, subclass 23.1

Applicant hereby elects, **with traverse**, to prosecute claims 1, 2, 4, 5, 7-9, 11, 16, 21-23, 28, and 71-74 (Group I) in the event that the restriction requirement is maintained.

In the February 1, 2006 Office Action, it was asserted that Inventions I and II are related as process of making and product made; and that the inventions are distinct if the process as claimed can be used to make other and materially different products. The Office suggests that the process of group I can be used to make the product in group II but also other nucleic acid-based products such as those amplified directly from clinical samples, or making substrates for additional analysis such as sequencing or RFLP analysis.

Applicant points out, however, that all of the base claims of group I include in the claimed process the step of synthesizing the reference nucleic acid(s) to be tagged and amplified, and the product claims of group II are limited to these synthesized reference nucleic acids. So, the actual process defined in the claims of group I could not be used to amplify just any nucleic acid-based products, e.g., “products directly from clinical samples,” but only the specified synthesized reference nucleic acids, etc. Also, the claims of group II do not name any specific nucleic acids, but only a type of nucleic-acid product made by the process of group I.

MPEP 803 states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Applicant contends that the search and examination of the pending claims can be made without serious burden to the Examiner because the search required for group II will require searching for elements that are included in one or more of the claims in Group I.

Thus, the Applicant respectfully submits that the restriction requirement is improper and should be withdrawn.

Conclusion

Applicant respectfully requests withdrawal of the restriction requirement, and issuance of the subject application.

Date: March 1, 2006

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Mark C. Farrell". The signature is fluid and cursive, with the first name "Mark" being more prominent.

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